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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,088	04/07/2000	Charles Gilbert Heisinger JR.		1969

7590 07/03/2006

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EXAMINER

FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 07/03/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/545,088
Filing Date: April 07, 2000
Appellant(s): HEISINGER, CHARLES GILBERT

Charles G. Heisinger, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/07/06 appealing from the Office action mailed 08/02/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is not correct.

In view of appellant's argument(s) in the Appeal Brief, the rejections under 35 U.S.C.112 and 101 have been withdrawn.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5884032	Bateman	3-1999
5913210	Call	6-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-40, 44 and 57-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,884,032 issued to Bateman et al., ("Bateman") in view of U.S. Patent No. 5,913,210 issued to Call ("Call").

As per claim 36, Bateman discloses "method of addressing an electronic message" (see col. 4, lines 53-57), comprising the steps of:

"providing a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers" as a pc (4) capable of supporting generation of a URL of the organization's product and service database, (see col. 5, lines 3-12);

"providing a second database containing identification codes and addressing information corresponding to each identification codes" as the agent workstation computer (18) is set up to preview

the html page associated with the caller's URL before or while the outbound call is being made, (see col. 6, lines 48-50);

"receiving a telephone call from a user including one of the identification codes" as the information received from customer, including a caller identity, (see col. 6, lines 45-48 and col. 9, lines 31-32);

"identifying the received telephone number from the telephone call" as the two parties will be in full voice communication and will be viewing the same multimedia screen which prompted the customers question, (see col. 6, lines 56-58);

"retrieving the user information from the first database by comparing the receiving telephone number with the stored telephone numbers" as calls from cld's come in the database can correlate the associated caller and URL, (see col. 9, lines 21-32 and col. 9, lines 10-12);

"retrieving the addressing information corresponding to the received identification code" as a means for answering the call and viewing the customer relevant data simultaneously obtained by looking up the clid in a customer database, as calls from clid's come in the database can correlate the associated caller and url, (see col. 9, lines 21-32);

"addressing the electronic message according to the retrieved addressing information" as an html form including the user's ip address and url is tiled in automatically and forwarded to the outbounding system, (see col. 7, lines 1-5). Bateman does not explicitly disclose sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message. However, Call discloses a method for sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message (see Call col. 7, lines 10-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Bateman by sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message as disclosed by Call (see Call col. 7, lines 22-29). Such a modification would allow the method of Bateman to provide facilitating the transfer of information about products from manufactures (see Call col. 1, lines 32-35).

(10) Response to Argument

2. The Examiner will address the arguments in the order submitted by the appellant(s).

Appellant's argument(s) concerning the 35 U.S.C.112 rejection is persuasive; therefore, the 35 U.S.C.112 rejection has been withdrawn.

Appellant's argument(s) concerning ^{the}35 U.S.C. 101 rejection is persuasive; therefore, the 35 U.S.C. 101 rejection has been withdrawn.

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Argument

Appellant(s) stated, page 13, paragraph 3, that "claim 36 recites 'providing a first database containing stored telephone numbers and user addresses corresponding to each stored the stored telephone numbers' (although the Examiner substitutes 'user information' for user addresses). The Examiner alleges that Call discloses this feature as well and cites column 5, lines 3-12, which references Fig. 2. This section of Call and Fig. 2 deal with an incoming registration template 207 used to create records. Nowhere in that cite or on Fig. 2 is there a suggestion of storing telephone numbers and user addresses corresponding to each of the stored telephone numbers."

Response

In response to appellant's argument that "Nowhere in that cite or on Fig. 2 is there a suggestion of storing telephone numbers and user addresses corresponding to each of the stored telephone numbers." Call discloses a method for integrating services, wherein the method comprising a (www server) database can correlate the associated caller and URL (see col. 9, lines 26-32). Therefore, Call discloses the claimed limitations storing telephone numbers and user addresses corresponding to each of the stored telephone numbers.

Argument

Appellant(s) stated, page 17, paragraph 2, that "To establish obviousness based on the combination of elements disclosed in the prior art there must be motivation, suggestion or teaching, and the specific combination that was made by the Appellant. The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one ordinary skill in the art or, in some cases, the nature of the problem to be solved. In *re* Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). In order to establish a prima facie case of obviousness under 35 USC 103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak, 50 USPQ2d at 1617. Broad conclusionary statements standing alone are not "evidence."

Response

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In this case, Bateman does not explicitly disclose sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message. However, Call discloses a method for sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message (see Call col. 7, lines 10-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Bateman by sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message as disclosed by Call (see Call col. 7, lines 22-29). Such a modification would allow the method of Bateman to provide facilitating the transfer of information about products from manufactures (see Call col. 1, lines 32-35),

thereby improving the accuracy of the method and system for telephonically selecting, addressing, and distributing messages.

Further, the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned 1392, 170 USPQ 209 (CCPA 1971).

Argument

Appellant(s) stated, Page 20, paragraph 4, "It is respectfully submitted that the Examiner has misunderstood the specification and thought the Applicant was saying there is such a system. Since the Examiner acknowledges that the claim recites features not disclosed except in the allegedly admitted prior art, and a careful reading of the application shows that there was no admission of prior art, the rejection as applied should not stand. Thus, it is respectfully submitted that the Examiner has not sustained the burden of presenting a prima facie case as applied to claims 47-56."

Response

In response to appellant's argument: Bateman discloses a method relates to accessing remote information network services such as those of the World Wide Web (see Bateman col. 1, lines 8-10 and col. 2, lines 22-23). Call discloses a method and apparatus for disseminating information about products manufactured and distributed through commercial channels (see Call col. 1, lines 6-9). Admitted prior art (APA) discloses a method and system for retrieving information in response to caller input from a telephone keypad and for delivering the information to an address specified by destination address information maintained through an Internet website and stored in a database, which is selected based on caller identification provided electronically with the inbound telephone call, and in a distribution means specified by the caller (see specification, page 1, lines 20-29). Therefore, the combination of Bateman,

Call and further in view of APA discloses the limitations of claims 47 and 56 as set forth: Bateman does not explicitly disclose an ANI for identifying the received telephone number from the telephone call. However, APA discloses an ANI for identifying the received telephone number from the telephone call (see APA, specification page 1, line 34 to page 2, line 5). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Bateman with AN as disclosed by APA (see APA page 2, lines 3-4. Such a modification would allow the method of Bateman to improve the reliability of the method and system for telephonically selecting, addressing, and distributing messages.

MPEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the rejections should be sustained.

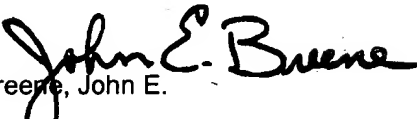
Respectfully submitted,

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